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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,467	11/28/2001	Kazuo Koide	13711-002001	5335
20985	7590	06/17/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER BISSETT, MELANIE D	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/997,467	<b>Applicant(s)</b> KOIDE ET AL.	
	<b>Examiner</b> Melanie D. Bissett	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16-21, 24 and 25 is/are pending in the application.  
     4a) Of the above claim(s) 16-21, 24 and 25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/24/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

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1. The claim objection has been withdrawn based on the applicant's amendment.

The prior art rejections have been withdrawn based on the applicant's amendments.

### ***Election/Restrictions***

2. The applicant has requested that the method claims be rejoined once the independent claims from which they depend have been found allowable. Since the method claims will contain limitations of any allowable claims, the method claims will be rejoined when the independent claims from which they depend have been found allowable. However, it is noted that the method claims will need to be amended to fix antecedent basis issues. For example, some of the claims noted in the method claims have been canceled. Also, the limitations of the method claims should be reviewed to ensure antecedent basis, since the independent claims have been amended.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-8 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 5 recites a latex product treated with an external blocking agent, where the latex is added with a specified aluminum material comprising a compound selected from a list. The wording of the claim renders the claim indefinite, since it is unclear where the

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compound of the Markush group fits into the product. Does the applicant intend the compound as the blocking agent for the surface treatment or to be combined with the internal aluminum compounds?

6. Similarly, claim 6 recites a compound of a Markush group. The wording of the claim renders the claim indefinite, since it is unclear where the compound of the Markush group fits into the product. Does the applicant intend the compound as the blocking agent for the surface treatment or to be combined with the internal aluminum compounds? The same analysis applies for claim 8.

#### ***Claim Objections***

7. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10 recites that the latex is internally added with an anionic aluminate salt or nonionic aluminum hydroxide gel. However, this limitation is already present in claims 3-9. Thus, claim 10 fails to further limit claims 3-9.

#### ***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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9. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benton et al.

10. Benton discloses a carboxylated latex adhesive for carpets (abstract), where the latex preferably comprises styrene-butadiene or acrylonitrile-butadiene rubbers (col. 3 lines 64-67). The carboxylated polymers are crosslinked with a crosslinking agent chosen from a number of compounds. Those compounds include aluminate compounds, polyamines, polyepoxides, amino-formaldehyde resins, and urea-formaldehyde resins, where mixtures are also taught (col. 5 lines 1-23). Since mixtures of crosslinking agents are taught and since the adhesives are taught to have improved adhesion to the backing (col. 2 lines 16-27), it is the examiner's position that it would have been prima facie obvious to use a combination of aluminate compound and another noted crosslinking agent to obtain an adhesive material having equally improved adhesion to the backing. One of ordinary skill in the art would recognize that the carpet backing adhesive product, once cured and dried, would not have further adhesive or tack properties.

11. Regarding the limitation that the latex product is a dipped product, it is noted that the claim is written in product-by-process format. It is the examiner's position that the carpet backing substrate, if dipped into the adhesive, would have the same material features as a substrate coated with the adhesive. Thus, the application method does not provide a patentable feature in this case.

***Allowable Subject Matter***

12. Claims 1-4 are allowed.
13. Claims 5-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
14. Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
15. The following is a statement of reasons for the indication of allowable subject matter:
16. The closest prior art, Benton, discloses polymer latices that may be treated with an aluminate compound and another crosslinking agent. However, the reference does not teach the production of fingerstalls, gloves, condoms, or balloons. Also, the reference does not teach an externally surface-treated product. Therefore, it is the examiner's position that these limitations provide a novel and unobvious step over the prior art.

***Response to Arguments***

17. In response to the applicant's general argument that the prior art references do not teach non-adhesive products, it is the examiner's position that the term "non-adhesive" should be given its broadest interpretation since the term has not been specifically defined in the specification. A material having the ability to delaminate from any substrate can be said to have non-adherent properties. The adhesives produced

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by Benton form cured and dried products which would not further adhere carpet materials. They are used to bind the tufts of carpet to the substrate before cure and would not adhere to additional materials after cure. Thus, the products would be non-adhesive. Furthermore, the applicant has not *shown* that the latex products of the reference, after cure, would exhibit adhesive properties.

18. Regarding the general argument that the dipped products of the claimed invention are different from those of the prior art, it is noted that the claims are only drawn to latex products formed by a dipping method. It is the examiner's position that the products of Benton's invention, if formed by a dipping method, would be indistinguishable from those made by the exemplified coating methods. Thus, the dipping method of the formed product does not yield patentable weight in this case. The claims do not distinguish the invention over the prior art.

### **Conclusion**

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdb



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